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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/584,977

06/02/2000

Masanao Fujieda

04917.0075

3091

22852

7590

09/22/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

HESELTIME, RYAN J

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/584,977

Applicant(s)

FUJIEDA, MASANAO

Examiner

Ryan J Hesseltine

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 26 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 19-29.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

JINGGEWU
PRIMARY EXAMINER

Continuation of 2. NOTE: Independent claims 19 and 27 have been substantially amended and the new limitations would require further consideration.

Continuation of 5. does NOT place the application in condition for allowance because: On page 8, third paragraph, applicant states, "there is no suggestion or motivation in the reference, nor has the Examiner suggested any motivation to persons of ordinary skill in the art, to combine Flom and L'Esperance... Since no suggestion or motivation to make such alteration exists, this is not even a prima facie case of obviousness." The examiner respectfully disagrees. The examiner directs applicant's attention to page 3, paragraph 6 of the final Office Action mailed January 28, 2004, where the examiner states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate surgical correction data based on measured refractive data necessary for refractive correction as taught by L'Esperance in order to correct a patient's eye for refractive errors by providing an ophthalmologic surgeon with corneal thickness and topological data for a particular abnormal eye in order to determine the depth of surgical incision (column 2, line 58-62), and to record identifying data of the patient such as the age and sex of the patient and other factors which would allow close comparison of the evaluated eye with an idealized model (column 5, line 29-41)."

On page 8, fourth paragraph, applicant states, "Applicant respectfully requests entry of this Amendment under Rule 116 in order to place this case in condition for allowance or in better form for appeal. This amendment was not presented earlier, because the Examiner rejected these claims over the combination of Flom and L'Esperance for the first time in the Final Office Action." The examiner respectfully disagrees. This amendment does not place the case in better form for appeal and further consideration would be needed to determine if the amendment would place the case in condition for allowance since applicant's amendments raise new issues that were not previously considered. The examiner rejected these claims as being unpatentable over Flom in view of L'Esperance for the first time in the Final Office Action because applicant's amendments in response to the first Office Action prompted new grounds of rejection.